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AS PRECEDENT OF THE T.T.A.B.

**UNITED STATES PATENT AND TRADEMARK OFFICE**
**Trademark Trial and Appeal Board**
**P.O. Box 1451**
**Alexandria, VA 22313-1451**

Mailed: August 22, 2006

Cancellation No. 92043811

Roger Orozco and Nora Orozco

v.

Michael Hwang

**Before Bucher, Walsh and Cataldo,**
**Administrative Trademark Judges.**

By the Board:

On October 28, 2004, petitioners Nora and Roger Orozco filed a petition to cancel respondent's registration No. 2846833,[1] for the mark pictured below:


alleging that the mark so resembles petitioners' previously-used marks OAK TREE FARMS[2] and OAK TREE FARMS and Design,[3] pictured below:

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[1] Reg. No. 2846833 for the mark OAKTREE and Design, for "footwear," filed February 10, 2003; registered May 25, 2004.

[2] Petitioners have not alleged ownership of a federal application or registration for this mark.

[3] Ser. No. 78304288 for the mark OAK TREE FARMS and Design, for "footwear," filed September 23, 2003.


as to be likely, when used in connection with respondent's goods, to cause confusion, mistake or to deceive prospective customers.[4] Respondent has denied the essential allegations in the complaint and asserted the affirmative defense of laches.

The case now comes before the Board for consideration of petitioners' motion (filed January 11, 2006) for summary judgment on the ground of priority and likelihood of confusion between the marks at issue. Respondent filed a response that includes a cross-motion for summary judgment on the ground that petitioners lack standing to bring this action.[5] Petitioners filed a reply brief, which we have

[4] Although petitioners argue in their brief that they also own the marks OAK TREE and OAK TREE and Design, neither mark was pleaded in the petition to cancel. Accordingly, petitioners may not obtain summary judgment on a claim of likelihood of confusion with respect to these marks. See *Giant Food, Inc. v. Standard Terry Mills, Inc.,* 229 USPQ 955, 961 (TTAB 1986); TBMP § 528.07 (2d ed. rev. 2004)("A party may not obtain summary judgment on an issue that has not been pleaded").

[5] Respondent also alleges that he has not had a chance to complete his discovery. However, we do not construe respondent's cross-motion as including a motion seeking discovery under Fed. R. Civ. P. 56(f). Respondent has substantively responded to petitioners' summary judgment motion. A party able to fashion a response to a motion for summary judgment does not need discovery to be able to respond to the motion. See *Dyneer Corporation v. Automotive Products, plc.,* 37 USPQ2d 1251 (TTAB 1995).

considered, together with their response to respondent's cross-motion.[6]

After reviewing the arguments and supporting papers of the parties, we find that petitioners have not met their burden of establishing that no genuine issue of material fact exists as to their claim of likelihood of confusion.[7] At a minimum, genuine issues of material fact exist as to the similarity or dissimilarity of connotations and commercial impressions of the marks at issue.[8]

Accordingly, petitioners' motion for summary judgment is hereby denied.

Turning to respondent's cross-motion, we find that respondent has not shown that he is entitled to judgment as a matter of law on the issue of petitioners' standing to bring this case. Petitioners have standing on the ground

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[6] The parties' stipulated motion (filed February 15, 2006) for an extension of time for respondent to file his brief in response to petitioners' motion for summary judgment is granted. Contrary to petitioners' assertion, respondent is entitled to include a cross-motion for summary judgment with his response.

[7] Both parties submitted evidence in support of their motions, including petitioners' submission of their counsel's declaration, verifying a copy of respondent's answers to petitioners' requests for admissions. Petitioners argue that the answers were untimely filed, and ask that the answers be deemed admitted, including admissions relating to the likelihood of confusion factors under *E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). We decline to do so, as respondent has shown that his answers to the requests were timely filed.

[8] The fact that we have identified only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

that their trademark application for the mark OAK TREE FARMS and Design, serial no. 78304288, was refused registration based on alleged likelihood of confusion with respondent's registration. See TBMP § 309.03(b) and authorities cited in that section. To the extent that respondent is asserting that petitioners lack standing because they are not the true owners of the marks, respondent has not raised this issue as an affirmative defense in his answer and may not obtain summary judgment on the issue. See TBMP § 528.07(a) (2d ed. rev. 2004).

Accordingly, respondent's cross-motion for summary judgment is hereby denied.[9]

Concurrently with the filing of his cross-motion, respondent filed a motion to reopen[10] discovery and extend the trial periods in this case, alleging his reliance upon adverse counsel's agreement to file an extension request that was never filed. Respondent, himself fully aware of the closing date of the discovery period, has not shown that

[9] The parties should note that the evidence submitted in connection with their motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

[10] Inasmuch as respondent's motion was filed after the discovery period closed, we have treated his motion as one to reopen the discovery period rather than as one to extend. See Fed. R. Civ. P. 6(b); Trademark Rule 2.116(a), and TBMP § 509.01 (2d ed. rev. 2004).

his failure to act is the result of excusable neglect. See *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997); and TBMP § 509.01(b) (2d ed. rev. 2004). Accordingly, respondent's motion to reopen is denied.

Proceedings herein are resumed and trial dates are reset as indicated below. Discovery remains closed.

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| DISCOVERY PERIOD TO CLOSE: | **CLOSED** |
| 30-day testimony period for party in the position of plaintiff to close: | **December 1, 2006** |
| 30-day testimony period for party in the position of the defendant to close: | **January 30, 2007** |
| 15-day rebuttal period for party in the position of the plaintiff to close: | **March 16, 2007** |

**IN EACH INSTANCE,** a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.